

**REMARKS**

Claims 1-13 are currently pending in the above application.

Claim 8 is objected to under 35 U.S.C. §112, first paragraph, as not being enabling. Claim 13 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for the use of the trademarks Papermatch®. Claims 1-13 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite because the phrase "requiring less paint consumption" in Claim 1 implies a comparison and it is not clear what is being compared.

Claims 1, 3-5, and 11-12 stand rejected under 35 U.S.C. 102(e) as being anticipated by as being anticipated by Gundberg et al. (U.S. Patent No. 6,203,646). Claim 2 stands rejected under 35 U.S.C. 102(e) as being anticipated by as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being obvious Gundberg et al. Claim 2 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Carr et al. (U.S. Patent No. 1,463,671)(Note that the Examiner indicates this as the LAST reference). Claims 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Penz et al. (U.S. Patent No. 5,888,913). Claims 9, 10, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Melber et al. (U.S. Patent No. 4,898,892).

**Rejection of claim 8 under 35 U.S.C. §112, first paragraph**

Claim 8 stands rejected as not being enabling because water vapor transmission rate needs to be measured in specific standardized conditions. Applicants have added the applicable standard (DIN 52615 utilizing a wet cup process) used to measure water vapor transmission rate to claim 8. Support for this standard was provided in the Specification on

page 8, first full paragraph. Applicants respectfully submit that this change overcomes the Examiner's rejection. Reconsideration of claim 8 is respectfully requested.

**Rejection of claim 13 under 35 U.S.C. §112, second paragraph**

Claim 13 stands rejected under 35 U.S.C. 112, second paragraph, for the alleged improper use of the trademark Papermatch® in identifying the goods. Applicants have added "dispersion" after "Papermatch®". In so doing, Applicants note that the use of the trademark Papermatch® in connection with the word "dispersion" is proper, in that the trademark is not being used alone to describe the goods, citing *Ex Parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). It is respectfully submitted that this change satisfies the requirements of 35 U.S.C. 112, second paragraph. Reconsideration of claim 13 is respectfully requested.

**Rejection of claims 1-13 under 35 U.S.C. §112, second paragraph**

Claims 1-13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite due to the use of the phrase "less paint consumption" without any structure to compare. Applicants have removed the phrase from claim 1 and have further added "polymeric" before "wall covering". Support for these revisions is found in the Specification, e.g. page 3, second full paragraph. Reconsideration of claims 1-13 is thus respectfully suggested.

**Rejection of claims 1, 3-5 and 11-12 under 35 U.S.C. §102(e)**

Claims 1, 3-5 and 11-12 stand rejected as being anticipated by Gundberg (U.S. Patent No. 6, 203,646).

Gundberg discloses a fibrous thermoplastic netting layer adhered around at least a part of the surfaces of a mineral fiber base layer for use as thermal and acoustic insulation (see Column 1, lines 18-19 and Column 9, lines 50-51). No information is provided as to the surface characteristics of the netting layer, but one of ordinary skill would presume a "netting" to have a non-regular (paintable) surface structure, and therefore there is no teaching or suggestion in Gundberg to provide a *prima facie* basis for anticipation of the

claim. This fact is buttressed by the fact that an insulation material does not require a paintable outer surface in its end use.

The present invention, on the other hand, as in modified claim 1 (and dependent claims 2-13), describes a polymeric wall covering material, not an insulating material, having a thermoplastic coating material applied to the non-woven fiber tissue to provide a regular, paintable visible outer surface. As one of ordinary skill appreciates, a regular, paintable visible outer surface would allow paint or other surface enhancements to be applied to the outer surface more easily, therein improving the aesthetic characteristics of the fiber reinforced wall covering. A similar type surface enhancement would not be considered or even necessarily desired in an insulating material, which is typically not visible in actual use.

As such, modified claim 1, and dependent claims 3-5 and 11-12 are not anticipated by Gundberg. Reconsideration of claims 1, 3-5 and 11-12 is thus respectfully requested.

**Rejection of claim 2 under 35 U.S.C. §102(e) or, alternatively, under §103(a)**

Claim 2 stands rejected under 35 U.S.C. §102(e) or, alternatively, under §103(a). As described above, modified claim 1 is not anticipated by Gundberg. As such, dependent claim 2 is similarly not anticipated by Gundberg.

Further, Claim 2 is not obvious under §103(a) over Gundberg in view of Carr et al. (U.S. Patent No. 1,463,671). Applicants respectfully traverse the Examiner's rejection.

Carr et al. describes improvements in automatic draft regulators for furnaces. It does not relate, contrary to the Examiner's analysis, to corona discharge treatments. Applicants believe that the Examiner has mistakenly submitted the wrong reference for review, noting the different inventor name (Last instead of Carr) and subject matter (furnaces instead of corona discharge treatment). Appropriate clarification is respectfully requested.

Even assuming arguendo that Last describes a corona discharge treatment on the surface of a wall covering to increase its adhesion as the Examiner states, Applicants

respectfully submit that it would not have been obvious to combine Gundberg with Last as the Examiner proposes.

First, the Examiner's statement that the corona discharge treatment would inherently produce the claimed surface tension increase since it increases the adhesion of the film is not entirely correct. Improved adhesion, as one of ordinary skill appreciates, may be achieved through many different phenomenon, of which improved surface tension is but one possible result. Other possible methods for improving adhesion includes acid/base interactions, hydrogen bonding, chemical bonding, and improving the roughness of the surface, to name just a few. Without having the Last reference available, Applicants are left to speculate as to why the adhesion was improved.

Second, and perhaps most relevant, there is no reason to introduce a surface enhancement treatment to Gundberg as the Office Action proposes.

Section 2143 of the Manual of Patent Examining Procedure states that three basic criteria must be met for establishing a *prima facie* case of obviousness, stating:

"First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations."

"If the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Section 2142 MPEP, ch. 2100, p. 110. "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned."<sup>1</sup> One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.<sup>2</sup>

It would not be obvious to combine the Gundberg reference and the Carr et al. (or Last) reference to arrive at the present invention. No reason is shown why one of ordinary

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<sup>1</sup> In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), *citing In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

skill in the art would modify the Gundberg reference as the Office Action proposes. As indicated above, the fibrous thermoplastic netting layer adhered to a mineral fiber base layer in Gundberg is used as an insulator, not a polymeric wall covering, and is therefore used to improve the acoustical and thermal properties of the mineral fibers. The mineral fiber element is not used as a polymeric wall covering, hence enhanced surface tension characteristics would not be required or even necessarily desired. As such, there would be no reason to combine the corona discharge treatment described in the Carr et al. reference with Gundberg as the Office Action proposes.

Instead, the rejection relies upon the improper use of hindsight to recreate the presently claimed combination of ingredients. The invention is not obvious from the prior art itself. As stated above, one cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.<sup>3</sup>

Claim 2 is therefore non-obvious in view of the cited prior art. Reconsideration of claim 2 is respectfully requested.

**Rejection of claim 6 and 7 under 35 U.S.C. §102(e) or, alternatively, under §103(a)**

Claims 6 and 7 stand rejected as being unpatentable over Gundberg, as applied to claims 1, 3-5, and 11-12 above, as applied to Penz et al. (U.S. Patent No. 5,888,913). Applicants respectfully traverse the Examiner's rejection.

Penz et al. discloses a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber.

It would not be obvious to combine the Gundberg reference and the Penz et al. reference to arrive at the present invention. No reason is shown why one of ordinary skill in the art would modify the Gundberg reference as the Office Action proposes. As indicated above, the fibrous thermoplastic netting layer adhered to a mineral fiber base

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<sup>2</sup> In re Fine, 837 F.2d at 1075.

layer in Gundberg is used as an insulator, not a polymeric wall covering, and is therefore used to improve the acoustical and thermal properties of the mineral fibers. The mineral fiber element is not used as a polymeric wall covering, hence enhanced paintability characteristics would not be required or even necessarily desired. As such, there would be no reason to combine the paint enhancement characteristics described in the Penz et al. reference with Gundberg as the Office Action proposes.

Hence claims 6 and 7 are not obvious in view of the cited prior art. Reconsideration of claims 6 and 7 is respectfully requested.

**Rejection of claim 9, 10, 13 under 35 U.S.C. under §103(a)**

Claims 9, 10 and 13 stand rejected as being unpatentable over Gundberg, as applied to claims 1, 3-5, and 11-12 above, and further in view of Melber (U.S. Patent No. 4,898,892). Applicants respectfully traverse the Examiner's rejection.

Melber discloses a method for making an opaque coating comprising employing opacifiers into or onto the surface of thermoplastic microspheres.

It would not be obvious to combine the Gundberg reference and the Melber et al. reference to arrive at the present invention. No reason is shown why one of ordinary skill in the art would modify the Gundberg reference as the Office Action proposes. As indicated above, the fibrous thermoplastic netting layer adhered to a mineral fiber base layer in Gundberg is used as an insulator, not a polymeric wall covering, and is therefore used to improve the acoustical and thermal properties of the mineral fibers. The mineral fiber element is not used as a polymeric wall covering, hence enhanced opacifying characteristics would not be required or even necessarily desired. As such, there would be no reason to combine the opacifying enhancement characteristics described in the Penz et al. reference with Gundberg as the Office Action proposes.

Hence, claims 9, 10 and 13 are not obvious in view of the cited prior art. Reconsideration of claims 9, 10 and 13 is respectfully requested.

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<sup>3</sup> In re Fine, 837 F.2d at 1075.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant submits that claims 1-13 are in proper form and allowable over the cited prior art. The Examiner is invited to telephone the Applicants' undersigned attorney at (614) 321-7162 if any unresolved matters remain.

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